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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,925	08/31/2001	Robert J. Donald	44653A	2226

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THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION
P. O. BOX 1967
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EXAMINER

MULLIS, JEFFREY C

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,925

Applicant(s)

DONALD ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit 1711

All remaining rejections and/or objections follow.

In view of the papers filed 1-27-03, the inventorship of this non-provisional application has been changed by the deletion of James E. Pate, III.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Claims 1-7 and 9-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation thermoformed article does not appear in the specification as filed and is therefore new matter. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit 1711

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 9-13 are rejected under 35 U.S.C. § 102(a) as being anticipated by Fujiwara et al. (JP 11/286526).

See the previous Office action at page 3 line 7 et seq.

Claims 3-7 and 10-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujiwara et al., cited above in view of Ikematu (USP 5,189,110) or Hoeg (USP 3,598,886).

See the previous Office action at page 4 line 7 et seq.

Claims 1-7 and 9-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoeg et al. (USP 3,598,886).

Art Unit 1711

See the previous Office action at the paragraph bridging pages 6 and 7 et seq.

Claims 1-6 and 9-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kato (JP 2586575).

See the previous Office action at page 8 line 1 et seq.

Claims 3-6 and 9-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kato, cited above.

See the previous Office action at page 8 line 14 et seq.

Claims 1-7 and 9-14 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hahnfeld (any one of U.S. Patents 6,451,924 or 6,376,621 or 6,426,390 or 6,350,820).

See the previous Office action at the last complete paragraph on page 9 et seq.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 and 9-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable all claims of U.S. Patent No. 6,376,621 or 6,426,390 or 6,350,820. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set out in the previous Office action at page 11 line 6 et seq.

Applicants' arguments filed 4-30-03 have been fully considered but they are not deemed to be persuasive.

The Examiner has reviewed applicants' arguments regarding support for applicants' limitations in the present specification as well as in Serial No. 60/139074. However the Examiner can find no support for the broad generic limitation of "thermoformed article" in either the instant specification or in Serial No. 60/139074 nor can the Examiner find support for the broad limitation "pultruded article" in Serial No. 60/139074 although support appears to be present for the term "pultruded article" in the instant application, 09/943,925. Therefore it is still the position of the Examiner that the effective filing date of the instant case is that of Serial No. 09/575,062, namely 5-19-00. Therefore any U.S. patent relied upon above with a filing date prior to 5-19-00 or any foreign patents relied upon above with a publication date prior to 5-19-00 are also prior art.

Art Unit 1711

With regard to Hoeg et al., Example 71 appears to disclose molecular weights which are within the metes and bounds of the claims.

With regard to Kato, the optical media disk of Kato is thermoformed as described on page 6 of Kato.

With regard to double patenting rejections based on the Hahnfeld patents, the double patenting rejection based on U.S. Patent 6,451,924 is hereby withdrawn. With regard to the remaining Hahnfeld patents, applicants' claims are not limited to a polyisoprene block and any unexpected results based on use of an isoprene polymer block are therefore immaterial. Applicants' claims also are not limited to exclude optical media disks and in fact as set out above, optical media disks appear to be produced by a thermoforming process such as is explicitly recited by the claims. With regard to lamellar morphology, such is not excluded by the claims.

With regard to Hahnfeld '820, the limitation of use of diene polymer blocks of 120 monomer units or less is within the metes and bounds of the molecular weights required by the instant claims.

With regard to applicants' amended IDS, the author is still not present in the citation.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS

Art Unit 1711

ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (703) 308-2820. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be

Serial No. 09/943,925

-8-

Art Unit 1711

reached on (703) 308-2462. The fax phone number for this Group is before final (703) 872-9310 and after final (703) 8729311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

J. Mullis:cde

July 9, 2003

Jeffrey Mullis
Primary Examiner
Art Unit 1711

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a series of loops and a long horizontal stroke.